

REMARKS

In the application claims 1-24, 29, and 31 remain pending. Claims 25-28, 30, and 32-40 have been canceled without prejudice. The pending claims presently stand rejected. The reconsideration of the rejection of the claims is respectfully requested.

Pending claims 1-24, 29, and 31 presently stand rejected as being rendered obvious by Darbee (US 6,278,499) in combination with Acevedo (US 5,818,361).

In response it is respectfully submitted that, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claimed elements. Thus, mere identification in the prior art of each claimed element is insufficient to defeat the patentability of the claimed subject matter as a whole. Rather, to establish a *prima facie* case of obviousness based upon a combination of elements disclosed in the prior art, a rejection must articulate the basis on which it concludes that it would have been obvious to combine the elements to arrive at the invention claimed. In practice, this requires that the rejection explain the reasons why one of ordinary skill in the art would have been motivated to select the references and combine them to arrive at the invention claimed. The rejection of the claims may not rely solely upon a naked allegation that the references can be combined. (MPEP § 2143.01).

Considering now the Office Action, it is respectfully submitted that the rejections set forth in the Office Action provide no explanations or reasons as to why one of

ordinary skill in the art would have been motivated to modify Darbee based upon the teaching of Acevedo. Instead, the rejections set forth in the Office Action are based upon nothing more than a naked assertion that one of ordinary skill in the art would have been led to modify Darbee because Acevedo allegedly discloses those claimed elements that are missing from Darbee. Since it is well settled that the absence of explanations or reasons to support a conclusion of obviousness evidences that a rejection of the claims could only have been arrived at through the impermissible use of hindsight reasoning, it is respectfully submitted that the Office Action fails to present a *prima facie* case of obviousness and, as such, the rejections of the claims must be withdrawn. *In re Rouffet*, 149 F.3d 1350, 1358 (Fed. Cir. 1998).

It is further respectfully submitted that the rejections of the claims must be withdrawn for the reason that neither Darbee nor Acevedo, whether considered alone or in combination, disclose each and every element set forth in the claims. That Darbee fails to disclose the claimed controlling circuit that allows transmission of a signal to a target device in response to activation of a key only when a means for indicating associated with the key is active has been acknowledged in the Office Action. It is respectfully submitted that Acevedo also fails to expressly or inherently disclose this claimed element.

Considering now Acevedo, Acevedo discloses a system in which keys of a keyboard are illuminated by software operating on a computer to thereby display indicia relevant to the function of the key during operation of the software, e.g., the indicia may be pictures of fire buttons, ray guns, laser guns, etc. when used in connection with gaming software. While Acevedo further describes that, to prevent confusion and

eliminate clutter, the keys that are not relevant to the software currently being employed are rendered blank, nowhere does Acevedo expressly describe that the system allows transmission of signals to the computer only through use of the keys that have illuminated indicia. Similarly, nowhere does Acevedo expressly describe that the system inhibits transmission of signals to the computer when keys that do not have illuminated indicia are activated. Thus, nowhere does Acevedo expressly describe, teach, or suggest that which is missing from Darbee.

It is further respectfully submitted that Acevedo cannot be said to inherently describe, teach, or suggest that which is missing from Darbee. In this regard, to be “inherently” described in a reference, the reference “must make clear that the missing descriptive matter is necessarily present in the thing described and that it would be so recognized by persons of ordinary skill.” Inherency “may not be established by probabilities or possibilities.” *Continental Can Co. USA v. Monsanto Co.*, 948 F.3d 1264 (Fed. Cir. 1991). Since it is likely that the keys of the keyboard of Acevedo always send a signal to the computer of Acevedo when activated without regard to whether or not the keys have illuminated indicia, with the operating software merely ignoring signals received as a result of keys being activated that are not relevant to the operation of the software, i.e., signal received in response to activation of keys having non-illuminated indicia, it is submitted that the disclosure of Acevedo cannot be said to make clear that the missing descriptive matter is necessarily present in the thing described and that it would be so recognized by persons of ordinary skill in the art as is required of inherency. Thus, it is respectfully submitted that Acevedo fails to expressly or inherently suggest modifying Darbee to arrive at the invention claimed. For this further reason it is

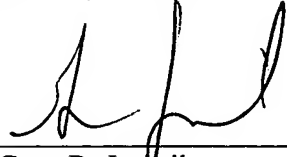
respectfully submitted that the combination of Darbee and Acevedo fails to present a *prima facie* case of obviousness and, as such, the rejection under 35 U.S.C. § 103 must be withdrawn.

Conclusion

The subject application is considered to be in condition for allowance. Such action on the part of the Examiner is requested.

Should it be determined, however, that a telephone conference would expedite the prosecution of the subject application, the Examiner is respectfully requested to contact the attorney undersigned.

Respectfully Submitted

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